Mailed: November 18, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re American Airpower Heritage Museum

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Serial Nos. 76144075, 76144076, 76158198, 76165093, 76149868, 76149869 and 76173211

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Wendy K. B. Buskop of Buskop Law Group, P.C. for American Airpower Heritage Museum.

Margery A. Tierney, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

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Before Hohein, Chapman and Drost, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

American Airpower Heritage Museum (a Texas non-profit organization)[1] has filed ten applications which have been appealed to the Board.[2]

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[1] When the Examining Attorney inquired as to whether applicant was a corporation, applicant responded by stating that "Applicant is not a corporation but a Texas non-profit organization organized under Texas law." (See applicant's January 2, 2002 response, p. 2 in application Serial No. 76173211.)

[2] Application Serial Nos. 76148150 and 76165096 (both for the mark SACK TIME and design, the former for goods in International Class 16 and the latter for goods in International Class 9) will be remanded to the Examining Attorney for consideration of the substitute drawing submitted in each case with applicant's reply

Of the ten applications, the seven which are the subjects of this opinion were filed by applicant to register on the Principal Register the six different marks shown below. All seven applications are based on applicant's assertion of a bona fide intention to use the mark in commerce.

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brief; and application Serial No. 76158188 (for the mark NIGHT MISSION and design for goods in International Class 9) was remanded to the Examining Attorney at her request by Board order dated May 21, 2004.

[3] Application Serial No. 76144075, filed October 10, 2000 for goods ultimately amended to read "printed matter, namely, newsletters, brochures, books in the field of aviation history, postcards, greeting cards, posters, stationary [sic] and flyers, in the field of aviation history" in International Class 16. The application includes the following statements: (i) "The mark consists of a black and white drawing of the mark with the words 'O-O-Nothing' and the image of a woman"; and (ii) "Applicant asserts this is not a portrait of an individual, but an image contrived from the heads of some unknown painter[s] during Word War II."

[4] Application Serial No. 76144076, filed October 10, 2000 for goods ultimately amended to read "printed matter, namely, newsletters, brochures, books in the field of aviation history, postcards, greeting cards, posters, and stationary [sic], in the field of aviation history" in International Class 16. The application includes the following statements: (i) "The mark consists of a black and white drawing of the mark that contains a photographic image"; and (ii) "Applicant asserts this is not a

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portrait of an individual, but an image contrived from the heads of the service men who painted the image during Word War II."

[5] Application Serial No. 76158198, filed November 2, 2000 for goods ultimately amended to read "printed matter, namely, newsletters, brochures, books in the field of aviation history, postcards, greeting cards, posters, and stationary [sic], in the field of aviation history" in International Class 16. The application includes the following statements: (i) "The mark consists of a black and white drawing of the mark that contains a photographic image"; and (ii) "The portrait in the mark does not identify a living individual, but an image contrived from the heads of the painters during Word War II."

[6] Application Serial No. 76165093, filed November 14, 2000 for goods ultimately amended to read "printed matter, namely, newsletters, brochures, books in the field of aviation history, postcards, greeting cards, posters, and stationary [sic], in the field of aviation history" in International Class 16. The application includes the following statements: (i) "The mark consists of a black and white drawing of the mark that contains a photographic image"; and (ii) "Applicant asserts this is not a portrait of an individual, but an image contrived from the heads of the painters during Word War II."

[7] Application Serial No. 76149868, filed October 19, 2000 for goods ultimately amended to read "printed matter, namely, newsletters, brochures, books in the field of aviation history, postcards, greeting cards, posters, and stationary [sic], in the field of aviation history" in International Class 16. The application includes the following statements: (i) "The mark

Following a convoluted history of these applications and the examination thereof, the Examining Attorney has ultimately refused registration in each application under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that each of applicant's marks falsely suggests a connection with a particular artist. Specifically, the Examining Attorney takes the position that the first four marks reproduced above "falsely suggests a connection with the pin-up art of Alberto Vargas (later known as Alberto Varga)" (Examining Attorney's appeal briefs); and the last

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consists of a black and white drawing of the mark that contains a photographic image"; and (ii) "The likeness (or, 'portrait') in the mark does not identify a living individual."

[8] Application Serial No. 76149869, filed October 19, 2000 for goods ultimately amended to read "printed matter, namely, newsletters, brochures, books in the field of aviation history, postcards, greeting cards, posters, and stationary [sic], in the field of aviation history" in International Class 16. The application includes the following statements: (i) "The mark consists of a black and white drawing of the mark that contains a photographic image"; and (ii) "The likeness (or, 'portrait') in the mark does not identify a living individual."

Application Serial No. 76173211, filed November 30, 2000 for goods ultimately amended to read "computer software for use with aviation artwork which provides aviation artwork for display, creating images, archiving artwork displaying graphics and charts of historical data" in International Class 9. The application includes the following statement: "The mark consists of a black and white drawing of the mark that contains a photographic image." Although the Examining Attorney inquired about whether the image was the portrait of a living individual, and applicant responded, there is no statement with regard thereto entered in the application file. The application was originally filed based on Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), (use in commerce, with a claimed date of first use and first use in commerce of August 1999). However, in a response filed November 24, 2003 (via 'Express Mail') applicant amended the basis of the application to be under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b) (intent to use).

two marks (involving three applications) "falsely suggests a connection with [the pin-up art of] Gil Elvgren" (Examining Attorney's appeal briefs).[9]

When the refusals to register were made final, applicant appealed each refusal. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing in any of these applications.

In view of the common questions of law and fact which are involved in these seven applications, and in the interests of judicial economy, we have consolidated the applications for purposes of this final decision. (This decision will become part of the record in each separate application.)

In support of the Section 2(a) refusals, the Examining Attorney submitted in each application printouts of pages from applicant's website and printouts of pages from third-party websites, including articles about "nose art"[10] and printouts of pages showing the results of the first few

[9] The Examining Attorney originally issued a final refusal in all seven applications based on an asserted false suggestion of a connection with the pin-up art of Alberto Vargas. In the latter three applications, she withdrew the final refusals based on Alberto Vargas, and ultimately issued new final refusals based on the respective marks falsely suggesting a connection with the pin-up art of artist Gil Elvgren (see application Serial Nos. 76149868, 76149869 and 76173211).

[10] Information of record in these applications indicates that "aviation nose art" relates to the paintings by U.S. servicemen

pages of 129 hits in a Google search of "varga girls nose art" for the first four applications,[11] or, in the latter three applications, printouts of pages showing the results of the first few pages of 3,427 hits in an AltaVista search of "Gil Elvgren."[12] The evidence submitted by the Examining Attorney also includes, in each of the seven applications, a copy of a particular painting by the artist Alberto Vargas in application Serial Nos. 76144075 ("Patriotic Gal"), 76144076 ("Military Secrets"), 76158198 ("Warning Signal") and 76165093 ("Sleepytime Gal"), and a copy of a particular painting by the artist Gil Elvgren ("Double Exposure") in application Serial Nos. 76149868, 76149869 and 76173211.

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on the forward portions of the fuselages of airplanes during World War II to personalize the aircraft.

[11] According to information of record, Alberto Vargas (1896-1982) was born in Peru, and in 1916 he came to the United States and embarked on his artistic career. In the 1920's he became the painter of the Follies Girls for Florenz Ziegfeld; later moving into the "new" movie industry, painting promotional works of the stars and set designs; in 1940, he replaced George Petty (creator of the "Petty Girl") at Esquire magazine where he created his "Varga Girl"; in the 1950's he created works known as "Legacy Nudes"; and in the 1960's and 1970's his works were published in Playboy magazine. (See e.g., www.sfae.com/artists/vargas.)

[12] According to information of record, Gillette (Gil) Elvgren (1914-1980) was born in St. Paul, Minnesota, and in the mid 1930's he began his career as an artist at a Chicago advertising agency, Stevens and Gross. In 1937, he began painting calendar pin-up girls for a publishing company, Louis F. Dow; and he changed to Brown & Bigelow in 1944 or 1945 and worked for that company until 1972. (See, e.g., www.thepinupfiles.com/elvgren; and www.gilelvgren.com/bio.)

The Examining Attorney essentially contends in each case that the overall look of applicant's mark is a close approximation of the particular artist's work (Vargas or Elvgren); that the mark would be recognized by consumers as the close approximation pointing uniquely to the artist; that there is no association between applicant and the involved artist; and that the artist (Vargas or Elvgren) is sufficiently famous that a connection would be presumed by consumers.

Applicant urges reversal in each application, essentially arguing that each mark must be considered as a whole, including the words, and there are no words actually appearing in any of the pin-up art referenced by the Examining Attorney; that the words are the dominant feature of each of applicant's marks and the words are how consumers would refer to or request the goods; that Section 2(a) of the Trademark Act (false suggestion of a connection) protects individuals, but it does not protect particular styles of work or art; and that the evidence of record does not meet the test to establish that each mark falsely suggests a connection with the artist Alberto Vargas or the artist Gil Elvgren, respectively.

In support of its position, applicant submitted (i) printouts of pages from third-party websites relating to

various “pin-up girl” artists (including George Petty, Earl MacPherson, Edward Runci, Pearl Frush, Earl Moran, and William (Billy) DeVorss); and, except in the case of one application, (ii) the declaration of Tami O’Bannion, applicant’s director, regarding, inter alia, the history of applicant’s acquisition of the original artwork on aircraft fuselages, and the servicemen who painted the involved marks on the fuselages of airplanes during World War II.[13]

The issue before the Board in these seven applications is whether applicant’s six marks, as applied to the goods (printed matter or computer software), falsely suggests a connection with the artist Alberto Vargas (four applications) or Gil Elvgren (three applications) within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a).

As discussed by our primary reviewing Court in the case of University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the portion of Section 2(a) dealing with false suggestion of a connection resulted from the desire to give statutory effect to the notions of the rights of privacy and publicity, the elements of which are distinctly

[13] Application Serial No. 76144075 (for the mark “O-O-NOTHING!” and design) does not include a declaration from Tami O’Bannion.

different from the elements of a trademark infringement claim of likelihood of confusion, which is the essence of Section 2(d) of the Trademark Act. Specifically, the Court stated as follows (footnote omitted):

> Under concepts of the protection of one's "identity," in any of the forms which have so far been recognized, the initial and critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or "persona." …
>
> Thus, to show an invasion of one's "persona," it is not sufficient to show merely prior identification with the name adopted by another. Nor is it sufficient, as urged by the University, that the fame of the name of an institution provides the basis for protection in itself. The mark, NOTRE DAME, as used by Gourmet, must point uniquely to the University.

217 USPQ at 509.

Following the University of Notre Dame case, the Board enumerated the elements necessary to establish a claim under Section 2(a) (false suggestion of a connection) or to test the propriety of a refusal to register a mark based thereon. The elements are that: (i) applicant's mark (or part of it) must be shown to be the same as or a close approximation of the person's previously used name or identity; (ii) applicant's mark would be recognized as such

(i.e., the mark points uniquely and unmistakably to that person); (iii) the person in question is not connected with the goods or services of the applicant; and (iv) the person's name or identity is of sufficient fame that when it is used as all or part of applicant's mark for its goods or services, a connection with that person would be presumed by purchasers and potential purchasers. See Buffett v. Chi-Chi's, Inc., 226 USPQ 428 (TTAB 1985). See also, In re Sloppy Joe's International Inc., 43 USPQ2d 1350 (TTAB 1997); and In re Kayser-Roth Corp., 29 USPQ2d 1379 (TTAB 1993).

The Examining Attorney must accordingly establish a prima facie case that the mark falsely suggests a connection with the artist Alberto Vargas (four applications) or with Gil Elvgren (three applications). See In re Pacer Technology, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003), and cases cited therein.

The records herein include ample evidence to establish that Alberto Vargas and Gil Elvgren were successful artists who painted, inter alia, "pin-up girls," and that the respective artist created particular paintings which have significant similarities to the six marks applied for by applicant herein. However, in applicant's six applied-for marks, each include words, while the specific painting

pointed out by the Examining Attorney in each application (e.g., Patriotic Gal, Warning Signal, Double Exposure) as well as the artist's "pin-up girl" artwork in general (Vargas or Elvgren) do not include words. In addition, the drawing depicted in each of applicant's marks, although certainly reminiscent of the artist's specific painting referenced in the application, is not the same as the artist's specific painting. Moreover, there is scant evidence that the "pin-up girl" painting(s) of either Vargas or Elvgren amounted to the artist's name or identity in the minds of consumers. There are simply hundreds of "pin-up girl" art pieces. The fact that one artist paints a particular picture which another artist copies to some degree does not establish that the original particular picture amounts to that artist's name or identity. The case of Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 218 USPQ 1 (6th Cir. 1983) is distinguishable from the facts herein on many levels. For example, in that case, the defendant "admitted that it adopted the name 'Here's Johnny' because it identified appellant Carson. We do not understand appellee to even contend that that it did not successfully accomplish its intended purpose of appropriating his identity." 218 USPQ at 5.

We find that in these applications it has not been established that applicant's six marks are a close approximation of the respective artist's previously used name or identity (i.e, persona), much less what such name or identity respectively is. The first element of the test is not met.

Likewise, the record clearly does not establish that "pin-up girl" art in general is uniquely and unmistakably associated with either artist, Vargas or Elvgren. To the contrary, it is clear in these records that numerous artists were involved in painting "pin-up girls," particularly in the 1940s, which was the time during which applicant's various "nose art" design marks were originally painted on the fuselages of airplanes. Further, with regard to the specific painting referenced in each application by the Examining Attorney, there is no evidence that applicant's mark would point uniquely and unmistakably to Alberto Vargas or Gil Elvgren, respectively, based on the specific painting identified in each application. In fact, it is noteworthy that even the Examining Attorney originally made final the refusal to register in all seven applications based on her assertion that there was a false suggestion of a connection with Alberto Vargas, and thereafter she withdrew that refusal in three applications

and asserted a refusal of a false suggestion of a connection with a different artist, Gil Elvgren. Thus, we find that consumers would not recognize these six marks as pointing uniquely and unmistakably to the artist named by the Examining Attorney, and the second element of the test is not met.

There is no dispute that applicant is not connected with the artistic works of either Alberto Vargas or Gil Elvgren. Thus, the third element of the test for false suggestion of a connection is met.

Finally, as to the last element, the person's name or identity must be shown to be of sufficient fame that, when used on the involved goods, a connection between applicant and the named artist would be presumed by consumers. While there are articles and web sites referencing each artist's career and general successes, there is no evidence that the particular paintings deemed respectively to be the basis of each of these six marks is famous, and would be recognized by the purchasing public as identifying either Alberto Vargas or Gil Elvgren, such that a connection with the particular artist would be presumed. While there is no doubt that many of the "nose art" paintings on the fuselages of airplanes during World War II were inspired by magazine and calendar "pin-up girl" art, and that Alberto

Vargas' works in particular were widely copied therefor, the record does not establish that either Alberto Vargas or Gil Elvgren were sufficiently famous that consumers would view applicant's marks (in relation to applicant's identified goods), and presume a connection with the respective artist.[14] The fourth element of the test is not met.

Inasmuch as the ex parte records here do not establish that each of these six marks (for seven applications) falsely suggests a connection with the pin-up art of Alberto Vargas or that of Gil Elvgren, we must reverse. See In re Los Angeles Police Revolver and Athletic Club, Inc., 69 USPQ2d 1630 (TTAB 2003). See generally, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §19:76 (4th ed. 2001).

[14] Compare the case of Buffet v. Chi-Chi's, Inc., supra, wherein the Board denied applicant's motion for summary judgment and found genuine issues as to the elements of a Section 2(a) claim. There was extensive evidence providing factual support "for opposer's allegations that the song 'Margaritaville' and [Jimmy] Buffet are well-known and that Buffet has attempted, through his commercial licensing program, publicity, and entertainment services, to associate the term 'MARGARITAVILLE' with the public persona of Jimmy Buffet." 226 USPQ at 430.

Decision: The refusal to register under Section 2(a) is reversed in each of the seven applications.[15]

[15] We note, however, that if applicant ultimately submits a statement of use in any of these seven applications, the Examining Attorney would be free to consider the issue of whether or not the marks function as trademarks for the involved goods based on applicant's manner of use of the mark(s) on any specimen(s).